

REMARKS

Applicant thanks the Examiner for identifying allowable subject matter in claim 7. New claim 11 includes the limitations of claim 7 and the claim from which claim 7 depended (original claim 1). Applicant respectfully submits that, in accordance with the Examiner's remarks, this new claim is in condition for allowance.

In the Office Action, claims 1-6 and 8-10 were rejected. Claims 1, 2, 4 and 5 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as allegedly rendered obvious by U.S. Patent No. 3,913,377 to Lindeman (hereinafter "Lindeman"). Claims 3, 6 and 8-10 were rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by Lindeman.

Claims 1-5 were further rejected under 35 U.S.C. § 102(b) as allegedly anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as allegedly rendered obvious by U.S. Patent No. 6,112,573 to Thelen (hereinafter "Thelen"). Claims 6 and 8-10 were further rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by Thelen.

Claim 1 has been amended to correct informalities. New claims 11-13 have been added. Each of these amendments and additions is supported by the specification. *E.g.*, Specification, ¶¶ [0003] and [0020].

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1, 2, 4 and 5 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Lindeman. Claims 1-5 were further rejected as allegedly anticipated by Thelen. Applicant respectfully traverses these rejections.

Claim 1 as presently amended is directed to a method for determining the current state of a lubricant wherein, *inter alia*, said determination of the current state of a lubricant is performed in a vehicle during use.

No such method is described in or suggested by Lindeman or Thelen.

Lindeman describes a friction testing machine for lubricants. *See* Lindeman, col. 1, lines 3-4. Thelen describes a process for determining the lubricant power of lubricant

oils for slip-controlled clutches. *See* Thelen, Abstract. The process described in Thelen operates within a test container. *See id.*

Lindeman and Thelen each describe the use of stationary arrangements for determining the current state of a lubricant within test apparatus. Lindeman and Thelen fail to disclose or even remotely suggest the determination of the current state of a lubricant in a vehicle or during use.

Anticipation under 35 U.S.C. §102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention. *See, e.g., Apple Computer, Inc. v. Articulate Systems, Inc.*, 57 U.S.P.Q.2d 1057, 234 F.3d 14 (Fed. Cir. 2000).

Accordingly, because Lindeman and Thelen each fail to disclose or suggest at least these claimed limitations, they cannot properly anticipate claim 1. Applicant respectfully submits that claim 1 as presently amended is in condition for allowance. Additionally, because claims 2-5 each depend from claim 1, it is respectfully submitted that these claims are in condition for allowance as well.

#### Claim Rejections Under 35 U.S.C. § 103(a)

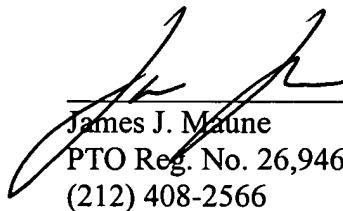
Claims 1-6 and 8-10 were rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by Lindeman and Thelen. Applicant respectfully traverses these rejections.

As discussed above, Lindeman and Thelen each describe the use of stationary arrangements for determining the current state of a lubricant within test apparatus. Lindeman and Thelen fail to even remotely suggest the determination of the current state of a lubricant in a vehicle or during use. Indeed, the fact that these references both describe stationary use of a lubrication test process within a test apparatus tends to suggest that these references teach away from the claimed invention. For at least these reasons, Lindeman and Thelen cannot properly render claim 1 unpatentable. Accordingly, Applicant respectfully submits that claim 1 as amended is in condition for allowance. Additionally, because claims 2-6 and 8-10 each depend from claim 1, it is respectfully submitted that these claims are also in condition for allowance.

**CONCLUSION**

In view of the foregoing amendments and remarks, favorable consideration and allowance of claims 1-13 are respectfully solicited. In the event that the application is not deemed in condition for allowance, the examiner is invited to contact the undersigned in an effort to advance the prosecution of this application.

Respectfully submitted,



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